

REMARKS

Claims 59-61, 63-102, and 104-116 are pending. Claims 91, 92 100, 101, 112 and 114 are withdrawn from consideration. By this amendment, claims 59 and 72 are amended. Support for this amendment is found throughout the specification and originally filed claims, e.g., at page 12, lines 19-21, original claim 62, Figures 14 and 15 and page 41, lines 18-20. No new matter is added by this amendment. Entry of this amendment is respectfully requested. Following entry of this amendment, claims 59-61, 63-102, and 104-116 will be pending

With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any objection and/or rejection made by the Office. Applicants expressly reserve the right to pursue prosecution of any subject matter not presently claimed in one or more future or pending continuation and/or divisional applications.

Applicants note with appreciation withdrawal of all rejections made in the non-final Office Action mailed September 9, 2005. In particular, Applicants note that the current claims are free of the art.

Request for rejoinder of withdrawn claims

Applicants respectfully request rejoinder of withdrawn process claims that depend from or otherwise include all of the limitations of allowable product claims, in accordance with the provisions of MPEP § 821.04.

Information Disclosure Statements

Applicants thank the Examiner for considering and initialing the PTO Forms 1449 that was mailed with the Office Action.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 59-61, 63-90, 93-99, 102, 104-113, 115 and 116 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that

[t]he limitation “amplifiable” is poorly defined, rendering the claims indefinite. The claims are directed to a fusion gene comprising a first selectable gene and an amplifiable second selectable gene. The claim limitation “amplifiable” is defined in the specification as “additional copies of the gene are generated which survive in intrachromosomal or extrachromosomal form” (p. 13, ¶2). As the first selectable and second amplifiable genes are fused on one polynucleotide, it is not clear how the second selectable gene could be amplified without amplification of

the first selectable gene. This ambiguity renders the claims indefinite. (Office Action, pages 2-3).

Applicants respectfully traverse this rejection.

The test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

In the rejection, the Examiner focuses on the meaning of the term “amplifiable”. However, claims 59 and 72 have been amended and now recite “wherein the first selectable gene is not an amplifiable selectable gene” (rather than “wherein the first selectable gene is not amplifiable”). “Amplifiable selectable gene” is defined in the specification at page 12, lines 13 to page 13, line 6. Applicants submit that the meaning of “amplifiable selectable gene” is clear when read in view of this definition and the specification, and withdrawal of this rejection, which is based on the alleged meaning of “amplifiable”, is respectfully requested.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 59-61, 63-90, 93-99, 102, 104-113, 115 and 116 are rejected under 35 U.S.C. § 112, as allegedly failing to comply with the written description requirement. Specifically, the Examiner states

[t]he disclosure contains no teaching with respect to a first selectable gene that is not amplifiable. Indeed, based on the definition of “amplifiable” provided in the specification wherein “additional copies of the gene are generated which survive in intrachromosomal or extrachromosomal form” (p. 13, ¶2), any gene may be considered “amplifiable” even if simply duplicated once. The disclosure is silent as to the particulars of how a selectable gene may not be duplicated or amplified. Further, as the first selectable gene and the second selectable gene are fused on one polynucleotide, then if the second gene is amplified then the first selectable gene would necessarily be amplified as well; it is not clear how the first selectable gene could not be duplicated or copied and therefore amplified. (Office Action, pages 3-4).

Applicants respectfully traverse this rejection. In the rejection, the Examiner focuses on the meaning of the term “amplifiable”. However, claims 59 and 72 have been amended and now recite “wherein the first selectable gene is not an amplifiable selectable gene” (rather than “wherein the first selectable gene is not amplifiable”). As noted above, “amplifiable selectable gene” is defined in the specification at page 12, lines 13 to page 13, line 6, and this amendment is fully supported in the specification and originally filed claims, e.g., at page 12, lines 19-21,

original claim 62, Figures 14 and 15 and page 41, lines 18-20. Accordingly, Applicants submit that the claims are fully described. Withdrawal of this rejection is respectfully requested.

SUMMARY

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is strongly encouraged to call the undersigned at the number indicated below.

In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
GENENTECH, INC.

Date: 3/22/07

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